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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,588	12/04/2001	Hiroyuki Miura	2224-0194P	6379

2292 7590 12/17/2002

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EXAMINER

ANDERSON, REBECCA L

ART UNIT PAPER NUMBER

1626

DATE MAILED: 12/17/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/980,588

Applicant(s)

MIURA ET AL.

Examiner

Rebecca L Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 1-35 are currently pending in the instant application.

#### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

Claims 1-35 are drawn to more than one inventive concept (as defined by PCT rule 13), and accordingly, a restriction is required according to the provision of PCT Rule 13.2.

PCT Rule 13.1 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 state that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex. B, Part 1(b), provides that "special technical features" mean those technical features, which, as a whole, define a contribution over the prior art.

Annex B, Part I(e), provides combinations of different categories of claims and states:

"The method for determining unity of invention under Rule 13 shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

Art Unit: 1626

(I) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for a use of the said product, or

(II) in addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process, or

(III) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product, and an independent claim for an apparatus or means specifically designed for carrying out the said process..."

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I claim(s) 1 (in part), 2-3, 18 and 34 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A1) a solvent crystallization step.

Group II claim(s) 1 (in part), 4-7 and 34 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A2) a cooling-crystallization step.

Group III claim(s) 1 (in part), 8, 9, 12-15 and 34 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (B) an extraction step.

Group IV claim(s) 10-11 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A1) a solvent crystallization step and an additional initial hydrolysis treatment.

Art Unit: 1626

Group V claim(s) 10-11 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A2) a cooling-crystallization step and an additional initial hydrolysis treatment.

Group VI claim(s) 10-11 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (B) an extraction step and an additional initial hydrolysis treatment.

Group VII claim(s) 16 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A1) a solvent crystallization step and an additional initial condensation step.

Group VIII claim(s) 16 (in part) ) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A2) a cooling-crystallization step and an additional initial condensation step.

Group IX claim(s) 16 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (B) an extraction step and an additional initial condensation step.

Group X claim(s) 17 (in part), 19 (in part), 20-22 and 34 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A1) and (C) a solvent crystallization step wherein the substrate is reacted in the additional presence of a co-catalyst.

Group XI claim(s) 17 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (A2) a cooling-crystallization step wherein the substrate is reacted in the additional presence of a co-catalyst.

Group XII claim(s) 17 (in part), 19 (in part), 25-27 and 34 (in part) drawn to the process for separating a reaction product and an imide compound from a reaction mixture which comprises (B) and (E) an extraction step wherein the substrate is reacted in the additional presence of a co-catalyst.

Group XIII claim(s) 19 (in part), 23-24 and 34 (in part) drawn to the process for separating an imide compound and a metal catalyst from a reaction mixture containing a metal catalyst which comprises (D) an absorption step.

Group XIV claim(s) 28 (in part) drawn to the process for separating an imide compound and a metal catalyst from a reaction mixture containing a metal catalyst which comprises (C) a solvent-crystallization step with an initial oxidation reaction of the substrate to obtain the reaction mixture.

Art Unit: 1626

Group XV claim(s) 28 (in part) drawn to the process for separating an imide compound and a metal catalyst from a reaction mixture containing a metal catalyst which comprises (D) an absorption step with an initial oxidation reaction of the substrate to obtain the reaction mixture.

Group XVI claim(s) 28 (in part) drawn to the process for separating an imide compound and a metal catalyst from a reaction mixture containing a metal catalyst which comprises (E) an extraction step with an initial oxidation reaction of the substrate to obtain the reaction mixture.

Group XVII claim(s) 29-32 and 34 (in part) drawn to a process for regenerating an imide compound.

Group XVIII claim(s) 33, 34 (in part) and 35 drawn to a process for producing an organic compound.

The inventions I-XVIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features that defines a contribution over the prior art. The processes as claimed in groups I-XVI are all processes for the separation of an imide compound from a reaction mixture, which does not define a contribution over the art as can be seen on page 3 of the instant specification, and is therefore not a special technical feature. The process of group XVII is for the regeneration of an imide compound which does not define a contribution over the art as can be seen on page 5 of the instant specification, and is therefore not a special technical feature. The process of group XVIII is a process for producing an organic compound by reacting an organic substrate in the presence of an imide compound, which does not define a contribution over the art as can be seen from the instant specification pages 1- 3, and is therefore not a special technical feature. The processes of inventions I-XVIII are different processes with different steps and/or reaction conditions and/or products. Accordingly, the unity of invention is considered to

Art Unit: 1626

be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37CFR 1.143. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

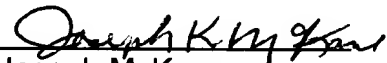
Art Unit: 1626

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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Rebecca Anderson  
Patent Examiner  
Art Unit 1626, Group 1620



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Joseph McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620